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625 SLATERS LANE

FOURTH FLOOR

ALEXANDRIA, VA 22314-1176

EXAMINER

MICALI, JOSEPH

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ADVISORY ACTION (*continued*)

The request for reconsideration has been considered but does NOT place the application in condition for allowance because: applicant has not made any amendments to the claims since prior to examiner issuing a final rejection. Furthermore, applicant presents the same grounds of argumentation already addressed in the previous office action (final rejection), as well as some new argumentation also addressed below.

Response to Arguments

1. Applicant's arguments filed August 12th, 2009 have been fully considered but they are not persuasive.

With regards to current argumentation, applicant relies on a previous point of contention: the claim language's use of the word "element". As applicant has supplied an M&W definition of "element", it is obvious that the examiner is correct in his reading of the claim language, as "element" is synonymous with "component" or "constituent", and thus, all represent the idea of the word meaning that an element is not the sole object but rather a part of the whole, such as with an oxide having the specifically claimed metals Nb, Ta, V, or Sm, Y, and Gd. Thus, given the broadest, reasonable interpretation of the claim language, examiner maintains proper analysis of the word "element" and subsequent rejection based on such in view of the prior art of record.

Furthermore, applicant addresses the critical temperature limitation, to which examiner maintains that such a property would be inherently shown in the combination of the prior art of record, absent evidence otherwise. As applicant has not supplied any evidence on the issue, examiner maintains the rejection of the claimed limitation of such a property.

Applicant has no further grounds of argumentation on the Paranthaman and Chen references and all other tertiary references.

Thus, argumentation is not persuasive.

Previous argumentation still applicable:

With regards the rejections using Paranthaman and Chen, applicant argues several issues. The first of which is that the references do not disclose a rare earth oxide superconducting layer with critical temperature of 85-88° K (pg 10-11). However, as the prior art teaches the rest of the claimed limitations, such a property would be inherently present in the superconductor. **MPEP 2112 [R-3]** states that, “Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable.” This is an instance of claiming a property not noted in the prior art but would be inherent given the rest of the claim language. In addition, applicants provide no proof that this feature is not inherent in the reference.

The second argument is that the references do not disclose the intermediate buffer layer cerium being paired with a solid solution formation element or a charge compensation element (pg 11-12). This is not persuasive. The claim language employs the word “comprising” so it allows for such selection of an oxide of an element, as the element is still present in the product. In addition, “element”, given its broadest reasonable interpretation, is not only limited to a metal material but any material that contains a metal (i.e. oxide). It is to be noted that the claims do not define that the material used is only a metal (i.e. a material consisting only of a metal selected from the group consisting of...). Finally, in addition to the interpretation above, the term “types”

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in claims 4-5 broadly refer to the rare earth metals and compounds thereof (i.e. oxide, etc.) since there is only one type of rare earth metal (i.e. rare earth metal), thus the “types” are interpreted to read on different compounds of the metals.

With regards the rejections using Paranthaman and Chen with Higashibata (pg 12-13), applicant does not make any new grounds of argumentation that have not already been addressed supra.

With regards the rejections using Paranthaman and Chen with Kojima (pg 13-15), applicant argues that none of the references properly teaching employing the MOD method. However, as applicant admits, Chen does disclose knowledge and usage of the MOD method (cited in the rejection above), and thus, such a claim limitation is rendered obvious to one having ordinary skill in the art at the time the invention was made. Furthermore, applicant attacks the Kojima reference for not teaching limitations that Paranthanman and Chen were used for; thus, such argumentation is not persuasive, as the Kojima reference is used to supply knowledge in the art of a possible heat treatment range. Even though the examples of Chen might not use the MOD method, this reference does teach that it can be used and as is well known, a reference is not only limited to the teachings in the examples.

/J.A. LORENZO/

Supervisory Patent Examiner, Art Unit 1793